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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,471	10/31/2001	Matthew W. Hickey	C063	4349
25784	7590	06/27/2008	EXAMINER	
MICHAEL O. SCHEINBERG P.O. BOX 164140 AUSTIN, TX 78716-4140				JANVIER, JEAN D
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/003,471	HICKEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JEAN JANVIER	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 February 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 19-29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 19-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

**Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/22/08 has been entered and a Non-Final Office Action fo

**DETAILED ACTION**

**Specification**

**Claim Status**

Claims 1-18 were canceled and new claims 19-28 were added. Thus, claims 19-28 are currently pending in the Instant Application.

**General Comments**

All scholarships have requirements, conditions or eligibility criteria that a candidate or a recipient must satisfy before he/she can receive a scholarship award.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor do they physically transform the underlying subject matter (such as an article or materials) to a different state or thing. Further, a web site, as recited in the claims, can simply be a collection of web pages (files) and does not necessary imply a piece of Hardware or an apparatus as herein expected.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19, 25, 27 and 29 (including their dependent claims) are rejected under 35 USC 112, second paragraph as being indefinite. Indeed, the claims recite the auxiliary verb may, which renders the claims indefinite since there is a level of uncertainty associated with “may”.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19-29 are rejected under 103(a) as being unpatentable over Ireland, USP 7,062,462B1.

As per claims 19-29, Ireland discloses a method of providing a user with education financing information, including the acts of: maintaining an electronic site on a computer network to which the user may connect; sending data to the user over the network for presenting at least one electronic screen containing financial award information concerning a potential student of an educational institution, the financial award information including a monetary award

(scholarship award) which may be used for the student to attend the educational institution and sending data to the user over the network when requested for presenting at least one electronic screen containing cost projection information, the cost projection information being a function of the award and including an amount of money required for the student to attend the educational institution (See abstract; ).

In general, many individuals require financial assistance in paying for an education, whether it be in the form of grants, scholarships, special employment (e.g., work-study programs), and/or loans. Many such educational institutions (e.g., schools, such as colleges and universities) provide various forms of assistance in obtaining financial aid for potential students (col. 1: 24-38). Financial aid office of schools, colleges and universities will mail many financial aid award packages (scholarship awards) to potential students with the hope that the financial aid award is attractive to the student and that the student will accept the award and attend the school. The cost for mailing many financial aid award packages can be substantial. For instance, each package may cost approximately \$10.00 to mail to 1000 potential students. Accordingly, schools are interested in other modes of transmitting financial aid award packages to their potential students, which are less costly (col. 1: 39-49). Further, a system called CollegeNET has been developed and offered by Sallie Mae, which provides a system for presenting financial award (including scholarship awards) information over the Internet to potential students. A particular school mails an award letter to a potential student, which includes a user name and password to access a secure website. The student logs onto the website and accesses their financial aid award package. The student can choose a preferred lender if a loan is awarded and input other information

**necessary for accepting the award. The student's response to the award is reported to the school (col. 2: 32-41).** Students obtain financial aid based on need or merit or a combination thereof (col. 2: 60-62; col. 3: 1-17).

(See col. 3: 20 to col. 5: 14).

**A plurality of school administrators 60 from a plurality of schools transmit financial award information, including scholarship award information, from their respective schools over the computer network 20 (Internet) concerning the potential students 50 (prospective scholarship recipients).** The microprocessor 12 and network interface 16 preferably respond by sending data over the network 20 for presenting at least one electronic screen (i.e., an electronic file containing information suitable for presentation to the students/parents 50), which contains the financial award information (fig. 1; col. 6:10-28). Next, **following a clearing process, a school administrator 60, from a particular school, preferably mails a letter to a potential student 50, which contains an announcement that a financial aid award package, including a scholarship award, has been granted to that student 50, meeting or satisfying one or more conditions or requirements or criteria (e.g. the student 50 has applied to the school), and may be obtained by visiting the website on the computer network 20. The letter preferably contains a URL address, user name and password (col. 6: 29-34).**

Once a student/parent successfully logs into the system website, the process flow and control causes the network server 10 to provide data presenting an electronic screen (interface) to the student/parent 50 representing the home page of the website (FIG. 3B). The home page includes an area 312, which identifies the student 50 by name, student ID or social security number, address, and telephone number. The name of the school may be provided at area 314

and a welcome message from that school may be included in area 316. With reference to FIGS. 3B, 2B and 2C, area 318 provides links to other portions of the website, in **particular: (i) instructions on how to use the application** may be activated and reviewed (step 238); (ii) a link to the student's 50 award package may be activated (step 210, FIG. 2C); (iii) a link to the policies, rules, **and/or regulations for financial aid and scholarships may be activated** (step 232) (iv) **a link to information about the school may be activated** (step 240); (vi) a link to security information about the website may be activated (step 244); and (vii) a link to additional information about the school, such as promotional material, may be activated (step 246) (in short, the student/parent fills out an electronic form or application for a scholarship award via a website over the Internet) . See col. 7: 11-31). Preferably, the amounts of grants 322A of fig. 3C, **scholarships** 322B, jobs 322C and loans 322D for at least individual school terms, school years, and totals for the school year 322E are featured on the website. Subtotals for the grants, **scholarships**, jobs, and loans are also preferably provided. At 322F, a total award package amount is provided, which indicates the amount of award money, which may be utilized by the student 50 to attend the school for the entire school year (**fig. 3C; col. 7:41 to col. 8: 6**).

**(With reference to FIG. 3C, a schematic representation of an electronic screen suitable for presenting the financial aid award package to the student/parent 50 is illustrated. The electronic screen includes an area 322, which contains the details of the financial aid award package. Area 322 preferably includes details on the sources of the funds for the award package, namely: (i) grants (e.g., Federal Pell grant, Federal SEOG, State grants) 322A; (ii) scholarships (e.g., institutional scholarships, non-institutional scholarships, State scholarships, private scholarships, etc.) 322B; (iii) jobs (e.g., Federal work study jobs,**

**institutional work study jobs, teaching assistanceships, etc.) 322C; (iv) and loans (e.g., Federal Perkins loans, Federal Unsubsidized Stafford loans, institutional loans, Plus loans, private loans, private signature loans, etc.) 322D.**

**Preferably, the amounts of the grants 322A, scholarships 322B, jobs 322C and loans 322D, are shown for at least individual school terms, school years, and totals for the school year 322E. Subtotals for the grants, scholarships, jobs, and loans are also preferably provided. At 322F, a total award package amount is provided which indicates the amount of award money, which may be utilized by the student 50 to attend the school for the entire school year. fig. 3C; col. 7:41 to col. 8: 6).**

It is expected here that a financial aid application form or a scholarship application form should be filled out online via the web site (i.e. electronic form) or off-line (paper form) by interested students and a student must satisfy some conditions or eligibility criteria before some sort of financial aid or scholarship award can be granted. In other words, a financial award, including a financial aid, scholarship, is granted to a candidate or prospective student based at least on merits (col. 2: 60-67).

**As per claims 19, 20, 22, 24-25 and 29, Ireland does not expressly disclose nominating or voting for one or more scholarship recipients via an online form (providing a form on a web site to nominate a scholarship recipient), providing a form on the web site to a nominee or members of the public to vote for other nominees or himself/herself (here, one single form can be used for both functions or for nominating and voting), preventing a**

**voter/nominee from voting multiple times and awarding a scholarship to the (first) recipient or nominee who receives the most votes or a predetermined number of votes at the end of a voting period (beyond which votes cannot be submitted or counted).**

However, the process of receiving by a center or a committee from a person (voter) a nomination on behalf of another person or recipient (second person or nominee) is old and well established in the art for many years. For example, the process by which elected officials are elected in a democratic system or country, such as the USA, allows one or more registered individuals or voters, including a candidate himself/herself, to visit a local voting location to vote for a single candidate (second person), including for himself/herself, among a plurality of candidates running for the same post or office (US Senate) during the primary or general elections, wherein the candidate with the most votes will win the race or the post (award or reward) and have a chance to serve or represent his constituency in Washington, D.C (The Nation's Capital). In general, despite some pitfalls, the system is considered to be for the most part fair and square. An election committee collects the votes from different local voting places and local precincts and sorts outs and tabulates and presents the final results. As the results are coming from different local precincts in different districts, it could be clear who the winners are going to be. Moreover, nominating a singer, an actor (actress or nominee) in different categories for a Tony Award or Grammy Award, nominating an individual to receive a "Nobel Prize" (Nobel Peace Prize or Nobel Prize in Literature, medicine etc.), nominating a teacher for the "Teacher of the Year Award" and nominating a fellow worker or employee by other employees for the employee of the month or the year depict one or more methods for receiving by a committee a nomination from a first person for recognition for a second person (nominee) so as

to provide an award or a prize to the nominee or second person if the nominee collects the most votes to thereby win the nomination.

Furthermore, it has been disclosed that local, State-wide, primary and general elections can be conducted over the Internet, wherein a voter, using a computer, can vote or nominate a candidate or a second person for a post or a position in the privacy of his own home. One having ordinary skills in the art would have understood that the election committee would have to use a server or web server (election server) connected to the Internet in order to receive the nominations or the votes from one or more voters on behalf of one or more candidates, wherein the one or more voters could use clients or personal computers coupled to the Internet to access a web site related to the election server in order to vote for one or more candidates.

In addition, it is well established in the industry, for example, that the National Basketball Association (NBA) receives nominations, via a form posted on its site, for players for different posts who will compose the All-Star Western and Eastern squads, nominations for the most valuable player (MVP) of the year or the Western and Eastern Conference Final or the NBA final, from individuals who access, using their clients or personal computers, the NBA web site having a web server for storing the various data or nominations submitted by these individuals or voters.

Additionally, a process to notify a winner in a primary or general election, a Nobel Peace Prize winner, the NBA MVP of the year, etc., is well expected in each of the scenarios described above. It is also understood that many intervening steps, agencies and officials or committee members may be involved in the different scenarios herein mentioned.

Moreover, the number of clients or personal computers and servers used (the amount of hardware) and the number of people or committee members or personnel involved in the decision making process to approve or reject a nomination for “The teacher of the Year Award” or the “Nobel Peace Prize”, for instance, vary from one committee to another and are unique and dependent upon a committee’s desires. Here, it is expected that a nominee for an award, such the “Tony Award”, or a prize, such as the “Nobel Peace Prize”, will be notified that he/she has been nominated for such an award or prize.

It is also common practice in the art that College Applicants are given a chance to receive a scholarship based one or more criteria including the writing of an essay in the end. The selection process or the winner(s) of the scholarship is performed via a nomination process. During the process, Applicants who are qualified to continue to compete for the scholarship receive an invitation or a notification, which is posted on a website.

In general, in all voting procedures, the candidate or nominee with the most votes wins.

It is well documented in the art to confirm a purchase or any other type of transaction, such as registering for an event, participating in a contest, etc., via e-mail.

Finally, using a form for nominating an award recipient and another form for voting for a nominee or award recipient is a matter of desires, which does not affect the functionality of the system, since a single form can be used for both nominating and voting for an award recipient or nominee.

“Official Notice”

Therefore, an ordinary skilled artisan, knowing the above information, would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the Ireland’s system so as to have a committee or a plurality of voters, including the candidates themselves, vote for one or more scholarship candidates by submitting their votes or ballots, via an online form, on behalf of the one or more prospective recipients or candidates, including themselves, wherein a notification process is used to announce the winner(s), meeting the eligibility criteria (e.g. candidate(s) wanting to attend a particular school or university related to a scholarship) and receiving the most votes, of a particular scholarship related to a specific school, thereby reducing the school or grantor’s liability by conducting a nomination and voting process to fairly determine from a pool of prospective recipients the “most aspiring” or “luckiest” scholarship candidates, receiving the most votes, who should in the end receive a scholarship award to attend the specific school selected by the candidates, especially when resources are scarce and a lot of respondents have shown interest in the scholarship, in response to the school administrator’s invitation or letter to offer a scholarship to students willing to attend the school, by visiting an associated website where they can receive more information about the scholarship featured in the administrator’s invitation or offer before the nomination or voting actually takes place.

As per claim 28, Ireland does not expressly teach posting a list of nominee identifiers to identify a nominee to a voter, the identifier not revealing the name or address of the nominee (not revealing the nominees’ names to the public).

However, as shown above, a list of the candidates is posted online in order for the voters to vote for at least a candidate for a particular position (NBA scenario). It is also common practice to post a list of identifiers or pseudonyms, instead of individuals' real names, in a "buddy list", thereby protecting the individuals' privacy, while maintaining confidentiality. "Official Notice"

Therefore, an ordinary skilled artisan, knowing the above information, would have been motivated at the time of the invention to incorporate the above disclosure ("Official Notice") into the Ireland's system so as to post online a list of identifiers or pseudonyms, representing scholarship candidates' or nominees' real names, and to have a committee or a plurality of voters vote for one or more nominees by selecting one or more related identifiers therefrom, thereby protecting the individuals' or nominees' privacy and maintaining confidentiality, while keeping the selection or decision process fair and square by avoiding nepotism or favoritism since the voters do not know the real names of the nominees for whom they are voting for, but their credentials or accomplishments.

### **Response to Applicant's Arguments**

First of all, the Examiner approves the new title of the invention: "Scholarship Award Method Using Voting".

Applicant's arguments with respect to claims have been considered, but are moot in view of the new ground(s) of rejection. In other words, Applicant's arguments are fully addressed in the above Office Action.

Further, contrary to the Applicant's arguments, the fact that a financial aid award or a scholarship award supposedly requires that candidates meet some sort of eligibility criteria does not eliminate the need for a nomination and voting system. In fact, without some kind of

eligibility criteria imposed therein, an elementary school student, for instance, might visit the web site and apply for a scholarship award to attend a University. This would have caused a lot of problems and even triggered some unnecessary system bottleneck.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not persuasive.

### **Conclusion**

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

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06/22/08

/J. J./

/Jean Janvier/

Primary Examiner, Art Unit 3688

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